

REMARKS:

The Office Action dated February 6, 2007, has been received and carefully reviewed. The preceding amendments and the following remarks form a full and complete response thereto. Claims 1, 5, 9, 10 and 11 have been amended. New claims 12 and 13 have been added. Support for the amendments can be found, inter alia, at paragraphs 0014, 0016 and 0041 of the present application. No new matter is added. Accordingly, claims 1-13 are pending in the application and submitted for reconsideration.

Claims 5 and 9-11 were rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Claims 5 and 9-11 have been amended. Applicant submits that claims 5 and 9-11 comply with the requirements of 35 U.S.C. §112. Accordingly, Applicant requests that the rejection be withdrawn.

Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application No. 2003/0181823 to Gatto in view of U.S. patent No. 4,651,753 to Lifton. Applicant traverses the rejection and submits that the combination of cited prior art fails to disclose or suggest each and every element of the claims and further, that there would have been no reason to combine the prior art as suggested in the Office Action.

The Office Action admits that Gatto fails to show or describe each and every element of the claims. Two features that Gatto fails to describe are the claimed lateral opening in the side surface of the cannula and the step of separating the tissue sample from the rest of the tissue by moving for the endoscope across the lateral opening.

See, page 5 of the Office Action. The Office Action attempts to cure the deficiencies of Gatto by providing and citing Lifton. The general position was taken in the Office Action that it would have been obvious to one skilled in the art to modify the cannula of Gatto to include a lateral opening as disclosed in Lifton and further, to use a reciprocating endoscope with the cannula of Gatto similar to the plunger in Lifton. Neither of the references disclose or suggest the use of the endoscope for separating the tissue sample with the endoscope and additionally there would have been no motivation to combine Lifton with Gatto as suggested.

Lifton was discussed in the background section of the present application. It was pointed out that Lifton has several disadvantages including: (1) its instrument has a complex structure which runs counter to the goal of miniaturization, as is required for example, in use in milk ducts, (2) direct endoscopic monitoring of the removal of the sample is not enabling. The device of Lifton is inserted into a larger endoscope and utilizes a complex cutting blade/plunger for biopsying tissue. In contrast to Lifton, the present invention includes a smaller, simpler design: a cannula having a small diameter and a lateral side opening is used in conjunction with an endoscope that is inserted inside the cannula. The endoscope itself is used to biopsy the tissue.

The instrument by Lifton has a complex structure differing from the present one. The Lifton structure includes a cannula 1A (Fig. 1-2) which has a lateral opening 3 in its side surface. Within the cannula 1A there is axially moveable disposed a second cannula (knife blade 17) having a cutting edge 19. A third cylinder 12 is disposed within the knife blade 17. The biopsy is done by generating a vacuum by means of the third

cylinder 23 drawing the biopsy sample through the opening 3. Then the biopsy sample is separated by advancing the knife blade 17 (cf. Fig. 3A-3F). In contrast to the present invention, the separation of the sample is not performed by interaction of an endoscope being arranged within the cannula. No endoscope is arranged within the instrument disclosed by Lifton, but instead the instrument is adapted to be used along side or within a larger endoscope.

Gatto discloses a cannula into which an endoscope is inserted. However, the cannula uses a shovel nose for biopsying tissue and there is not disclosure or suggestion whatsoever to use a lateral side opening in conjunction with an endoscope for making the biopsy. Thus, neither reference discloses or suggests each and every feature of the claimed invention, and further, since the devices of Lifton and Gatto are different in nature, and since Lifton runs counter to the goal of miniaturization, one having ordinary skill in the art would not have chosen to combine the teachings of Lifton and Gatto as proposed by the Office Action. Accordingly, Applicant submits that the rejection of the claims is not proper and requests that the rejections be withdrawn.

In addition to the above-reasons, dependent claim 2 is also because it recites that the lateral opening includes a cutting region, which is neither shown nor suggested by the cited prior art.

In view of the foregoing, the Applicant submits that claims 1-13 are in condition for allowance and request that claims 1-13 be allowed and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees maybe charged to Counsel's Deposit Account No. 02-2135.

Respectfully submitted,

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